

**Remarks/Arguments:**

The pending claims are 54-84 and 93-128. Although the Office Action Summary states that the pending claims are 54-84 and 93-121, paragraph 10 of the Detailed Action acknowledges that the application also contains claims 122-128. Claims 85-92 have been canceled previously. Claim 128 has been withdrawn from consideration.

**Information Disclosure Statement**

Applicants filed a Supplemental Information Disclosure Statement ("IDS") on December 2, 2005 which included a 12 page Form PTO/SB/08a listing a number of references for the PTO's consideration. Paragraph 3 on page 2 of the Office Action states that the PTO did not consider pages 11 and 12 of the Form PTO/SB/08a because, paragraph 3 of the Office Action concluded, Applicants did not comply with 37 CFR 1.98(a)(2). The words "No Copy" were written on pages 11 and 12. According to paragraph 3 of the Office Action, 37 C.F.R. § 1.98(a)(2) "requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed."

However, 37 C.F.R. § 1.98(d) states an exception to the copy requirements of § 1.98(a) where a copy of the patent or publication was previously submitted to the PTO in an earlier application and (1) the earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and (2) the information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

For the following reasons, Applicants come within the § 1.98(d) exception for the references identified on pages 11 and 12 of the Form PTO/SB/08a filed on December 2, 2005:

- all of the references were previously submitted in Application No. 08/312,881;
- the '881 application was identified on page 1 of the Information Disclosure Statement; and
- the Information Disclosure Statements submitted in the earlier '881 application complied with §§1.98(a) through (c).

**Brief explanation showing that the references on  
pages 11 and 12 have been filed in a priority application**

Copies of the references listed on pages 11 and 12 of the PTO/SB/08a filed in the present case on December 2, 2005 were previously submitted in separate IDS's at various times in priority application Serial No. 08/312,881. Some of the references listed on page 11 were submitted in IDS #1 described below and the remainder of the references listed on page 11 were submitted in IDS #2 described below. The references listed on page 12 were submitted in IDS #3 described below.

**IDS #1**

This IDS was received by the PTO in the '881 application on January 13, 1995. See, PTO-1449's attached as Exhibit 1 and printout of the Image File Wrapper listing of the '881 application in Private PAIR attached as Exhibit 3. The references in Exhibit 1 correspond to the bottom 7 documents listed on page 11 of the PTO/SB/08a filed in the present case on December 2, 2005.

**IDS #2**

This IDS was received by the PTO in the '881 application on April 27, 2001. See, IDS, PTO-1449, and date stamped postcard attached as Exhibit 2 and the printout of the Image File Wrapper listing of the '881 application attached as Exhibit 3. The references and the video cassette listed in Exhibit 2 correspond to the top 6 documents and the video cassette listed on page 11 of the PTO/SB/08a filed in the present case on December 2, 2005.

**IDS #3**

This IDS was mailed to the PTO in the '881 application on August 18, 2004 and received by the PTO on August 24, 2004. See, IDS, PTO/SB/08a/08b, and date stamped postcard attached as Exhibit 4. Because the Image File Wrapper listing for the '881 application does not show this IDS, Applicants have resubmitted it to the PTO, along with copies of the references. The references listed on the second page of the PTO/SB/08b in Exhibit 4 correspond to the two non-patent literature documents listed on page 12 of the PTO/SB/08a filed in the present case on December 2, 2005.

The PTO is able to review all of the references listed on pages 11 and 12 because they have been submitted to the PTO in the '881 application. If, however, the PTO is unable to locate any of those references, Applicants will supply another copy of them.

### **Claim Rejections - 35 U.S.C. § 102**

Paragraphs 5-10 of the Office Action have rejected all of the claims except claims 62-66 based on the PTO's denial of priority in paragraph 2 of the Office Action. Applicants believe that the denial of priority is erroneous for the reasons set forth below.

Since claims 62-66 have not been rejected, it is submitted that they are in condition for allowance. In addition, since the previous Office Action dated September 20, 2005 withdrew claim 128 from consideration as directed to a non-elected invention, Applicants request that the prior art rejection of claim 128 be withdrawn.

#### **Telephone interview with the Examiner**

Preliminarily, Applicants wish to express their appreciation for the courtesies extended to their representatives during a telephone interview with the Examiner on June 28, 2006.

The Examiner recognized that Applicants had copied claims from various patent properties. Because the pending claims were added by preliminary amendment, the Examiner assumed that the claims are directed to newly added disclosure and that the present application is a continuation-in-part application.

Applicants suggested that, if the Examiner believed that any of the claims introduced new matter, the proper procedure would have been to identify any such claims and reject those claims under § 112 - not to deny priority. Applicants also pointed out that the filing date of a continuation application is not determined by the date when claims are added to the application. Applicants pointed out that MPEP procedure (Section 608.04) requires the PTO to reject claims under § 112, first paragraph if the PTO believes that new matter has been added in the claims. Applicants also pointed out that Section 2163.04 of the MPEP places the burden on the PTO to provide a basis for such a rejection.

Applicants further pointed out that in two prior Office Actions, the PTO had rejected two sets of claims under 35 U.S.C. § 112, first paragraph, Applicants had shown where there was specification support for the rejected claims, that the PTO had not repeated the rejections in subsequent Office Actions, and therefore it was presumed that Applicants had overcome the rejections.

At the conclusion of the interview, the Examiner stated that Applicants only need to respond to paragraph 2 of the Office Action. The Examiner indicated that after Applicants respond to the Office Action, she may issue a new Office Action that would contain a §112 rejection and would withdraw the rejections in the currently pending Office Action.

### **Response to the Office Action**

In paragraph 2 of the Office Action, the PTO states that

[t]his application repeats a substantial portion of prior Application No. 08/463,987 and 08/317,763, filed 6/5/95 and 10/4/94, and adds and claims additional disclosure not presented in the prior applications. The claims of the present application direct [sic] to newly added disclosure. Therefore, the claimed invention has a priority date as of the filing date of the present application, which is 10/24/03.

As Applicants' representatives stated during the telephone interview, this paragraph of the Office Action is legally incorrect.

A Preliminary Amendment filed with the application on October 24, 2003 stated, in part:

This application is a continuation of Serial No. 08/463,987, filed June 5, 1995, now pending, which is a division of Serial No. 08/317,763, filed October 4, 1994, now U.S. Patent No. 5,609,627, which is a continuation-in-part of Serial No. 08/312,881, filed September 27, 1994, now pending. The present application is also a continuation-in-part of Serial No. 08/312,881.

As a result, the present application is entitled to the benefit of the September 27, 1994 filing date of prior nonprovisional application Serial No. 08/312,881. Support for the claims currently pending in the present application is found throughout the specification and claims of the earliest '881 application and in the later '763 and '987 applications. The Office Action fails to provide any legal basis for the PTO to take away Applicants' September 27, 1994 priority date.

Furthermore, if the PTO believes that there is no specification support for some or all of the claims, MPEP § 2163.06I specifies the correct course of action to be an identification of such claims and a rejection under 35 U.S.C. §112:

If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement.

Similarly, MPEP § 706.03(o) provides:

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. (citation omitted);

MPEP § 608.04 also provides:

If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed.

Furthermore, the PTO bears the burden of proving insufficient support for claims: "the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." MPEP § 2163II, quoting MPEP § 2163.04.<sup>1</sup> (emphasis added)

Accordingly, MPEP § 2163.04I requires the PTO to identify the claim limitation at issue and to "[e]stablish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed."

In fact, in two earlier Office Actions, the PTO did identify a number of claims which the PTO contended were not supported by the specification. Specifically, the Office Action mailed October 18, 2004 rejected claims 57-59, 61-63 under 35 U.S.C. § 112, first paragraph; and the Office Action mailed September 20, 2005 rejected claims 71-84, 101, 123-127 under 35 U.S.C. § 112, first paragraph. Applicants responded to each rejection, and the PTO did not repeat either rejection. Based upon the following statements in MPEP § 2163.04II and upon the PTO's decision not to repeat either §112 rejection, applicants are entitled to presume that the rejections were withdrawn:

Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office Action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. (emphasis added)

Since the PTO did not repeat either rejection and did not respond to any of Applicants' citations to the specification or their arguments, it must be assumed that the PTO was satisfied with Applicants' designations of specification support, and remains satisfied, and that there is now no basis for a rejection under 35 U.S.C. § 112.

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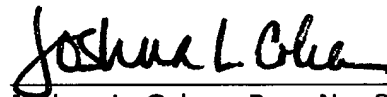
<sup>1</sup> Although MPEP § 2163 purportedly quotes MPEP § 2163.04, Applicants have not found the quoted language in MPEP § 2163.04.

Nevertheless, if the PTO properly rejects any of the pending claims under § 112 in conformity with the requirements of the MPEP and/or if the PTO properly rejects any of the pending claims based upon prior art without taking away Applicants' priority dates, Applicants will address those rejections. But, Applicants submit, there is no legal basis for the PTO to take away Applicants' priority dates during ex parte prosecution and then to make substantive claim rejections as if Applicants are not entitled to those priority dates.

**Conclusion**

For all of the above reasons, Applicants request the PTO to withdraw the rejections in the March 29, 2006 Office Action and to allow all of the pending claims. If, however, the PTO contends that any of the pending claims do not have specification support either in the present application or in any of the '987, '763, or '881 applications, the PTO is invited to make a § 112 rejection of specified claims in accordance with MPEP procedure, without taking away Applicants' priority dates.

Respectfully submitted,



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Attachments: Exhibits 1-4

Dated: August 7, 2006

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The Director is hereby authorized to charge or credit Deposit Account No. 18-0350 for any additional fees, or any underpayment or credit for overpayment in connection herewith.

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